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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,702	09/07/2004	Michael J Breslin	21047YP	3343

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MERCK AND CO., INC
P O BOX 2000
RAHWAY, NJ 07065-0907

EXAMINER

HAVLIN, ROBERT H

ART UNIT	PAPER NUMBER
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1609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/506,702

Applicant(s)

BRESLIN ET AL.

Examiner

Robert Havlin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,6-13,15,16,23-25,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) 7,11-13,15,16,23-25,35 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☒ Claim(s) 6 and 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/25/05, 3/6/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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DETAILED ACTION

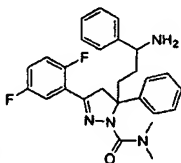
Claims 3, 4, 6, 7-13, 15, 16, 23-25, 35, and 36 are currently pending.

Election/Restrictions

1. Applicant's election with traverse of Group I:

Group I, claim(s) 1-10 in part, drawn to products of formula I, wherein the moiety Y-R2 is a phenyl optionally substituted with non-heterocyclic groups; the moiety W-R5 is a non-cyclic group; R3 and R4 are hydrogen; the Z-R6 moiety is a phenyl optionally substituted with non-heterocyclic groups; R1 is -C(O)-R1' as defined in claim 9. If this group is elected, applicant is required to elect a single species.

5-(3-amino-3-phenylpropyl)-3-(2,5-difluorophenyl)-N,N-dimethyl-5-phenyl-4,5-dihydro-1H-pyrazole-1-carboxamide



And the species

in the reply filed on

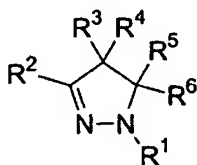
3/5/2007 is acknowledged. The traversal is on the ground(s) that there does exist a special technical feature in claim 3 and there is a lack of search burden. This is not found persuasive because as cited in the requirement for restriction, pyrazoline compounds are well known in the art and in fact the previously cited reference teaches cyclic substituents at the 1-, 3-, and 5- positions and thus the instant application is not a contribution over the prior art. Furthermore, there does exist a search burden due to the large number of possible combinations of the variable groups R1, R2, R3, R4, R5, R6, R7, R8, R9, R10, Ra, Rb, and substitutions upon substitutions therein.

Therefore, as stated in item 3 of the restriction requirement, the election of Group I and the compound 5-(3-amino-3-phenylpropyl)-3-(2,5-difluorophenyl)-N,N-dimethyl-5-

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phenyl-4,5-dihydro-1H-pyrazole-1-carboxamide results in the following as the elected invention for search and examination.

The elected species is free of art and the search and examination was extended



to the products of the formula II II in which:

R1 is (C=O)-C₁₋₁₀-alkyl, (C=O)O-C₁₋₁₀-alkyl, (C=O)N(C₁₋₈ alkyl)₂

R2 and **R6** are phenyl, optionally multiply independently substituted with R7

R3 and **R4** are hydrogen

R5 is H, C₁₋₁₀alkyl optionally multiply independently substituted with R7

R7 is phenyl and -NH₂, (C=O)_aO_b-C₁₋₁₀-alkyl, halo, -OH, -CO₂H, -CN, or -CHO.

The remaining subject matter of claims 3, 4, 6, and 7-10 are withdrawn under 37 CFR 1.142(b) as being for non-elected subject matter. The remaining compounds which are not within the elected invention, which are independent and distinct from the elected invention and do not have unity with the elected compound and are therefore withdrawn by means of a restriction requirement within the claims are, for example, the compounds of formula II R1 is (C=O)aryl, (C=O)C₂-C₁₀alkenyl, (C=O)C₂-C₁₀alkynyl, (C=O)C₃-C₈cycloalkyl, (C=O)heterocyclyl, ..., etc..

The above mentioned withdrawn compounds which are withdrawn from consideration as being for nonelected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds differ from those of the elected invention, such as by piperidinyl, morpholinyl,

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pyrrolidinyl, etc. which are chemically recognized to differ in structure and function. This recognized chemical diversity of the compounds can be seen by the various classification of these compounds in the U.S. classification system, i.e. class 546 subclass (184)+ piperidinyl, class 544 subclass (106)+ morpholinyl, etc. Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition and have been restricted properly as a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter.

These withdrawn compounds are independent and distinct from the elected invention and do not have unity with the species elected and are therefor withdrawn by means of a restriction requirement within the claims.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

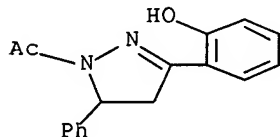
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Chimenti et al. (European Journal of Medicinal Chemistry 1992, 27(6), 633-9).

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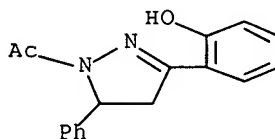
The claims are drawn to a broad genus of compounds including the species of



where R1=(C=O)CH₃; R2=2-phenoxy, R3 and R4=H; R5=H;

R6=phenyl.

Chimenti et al. (European Journal of Medicinal Chemistry 1992, 27(6), 633-9) teaches



the compound 2a (table I, page 635)

which clearly anticipates

the genus of claims 3 and 4.

Objections

Claims 3, 4, 6, 8-10 are objected to as containing non-elected subject matter.

Allowable Subject Matter

The searched and examined scope is considered allowable, as identified supra.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Havlin whose telephone number is (571) 272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Cecilia Tsang can be reached at (571)-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert Havlin
Examiner

RH


CECILIA TSANG
SUPERVISORY PATENT EXAMINER